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10/597,958	08/14/2006	Mirko Danz	DANZ-4	8432

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EXAMINER

DALENCOURT, YVES

ART UNIT	PAPER NUMBER
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2457

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ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary	Application No. 10/597,958	Applicant(s) DANZ ET AL.	
	Examiner YVES DALENCOURT	Art Unit 2457	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 December 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 17-32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 17-32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>12/17/2009</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This office action is responsive to amendment filed on 12/11/2009.

Response to Amendment

The Examiner has acknowledged the amended claims 17 – 19, 21 – 26, 28, the cancellation of claims 15 – 16, and the submission of new claim 29 – 32.

Response to Arguments

Applicant's arguments filed on 12/11/2010 have been fully considered but they are not persuasive.

In response To Applicant's argument (page 11, first paragraph) that Kumbalimutt does not disclose at least the features of a client checking whether it has an initial configuration data record that allows identification of its functionality, and the client requesting, if no initial configuration data record that allows identification of its functionality is present on the client, from the server an initial configuration data record; and the client identifying its functionality based on the initial configuration data record. The Examiner respectfully disagrees with Applicants' assertion because Kumbalimutt discloses that the client computer 150 encounters a condition that indicates that it needs to be configured for real-time communication. An example of such a condition is when a user at the client computer 150 installs a real-time communication program and the installation software requires the correct configuration settings. At step 12, the client computer 150 generates a request to the server computer 154 for the configuration

Art Unit: 2457

settings. At step 14, the server computer 154 retrieves the appropriate configuration setting from a storage medium. At step 16, the server computer 154 transmits a configuration document containing the configuration settings to the client computer 150. At step 18, the client computer 150 stores the configuration settings in a memory in a location that is accessible by a real-time communication client program executing on the client computer 150. The process then ends. The client computer 150 can now use the configuration setting to execute the real-time communication program and thereby perform real-time communication functions (col. 3, line 58 through col. 4, line 19).

Regarding Applicants' argument (pages 11 and 12), the Examiner contends that Kumbalimutt and Righi do read on claim 21.

In fact, Applicants are interpreting the claims very narrow without considering the broad teaching of the references used in the rejection. Applicants are reminded that the examiner is entitled to the broadest reasonable interpretation of the claims. The Applicants always have the opportunity to amend the claims during prosecution and broad interpretation by the examiner reduces the possibility that the claim, once issued, will be interpreted more broadly than is justified. In re Prater 162 USPQ 541, 550-51 (CCPA 1969).

Claim Objections

Claims 28 and 29 objected to because of the following informalities: It is suggested to delete "it" (claim 28, line 7; claim 29, line 5). Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 17 – 20 and 22 - 32 are rejected under 35 U.S.C. 102(e) as being anticipated by Kumbalimutt et al (US 7,266,594; hereinafter Kumbalimutt).

Regarding claim 26, Kumbalimutt discloses a method for starting up an automation component in an automation system, comprising the steps of: requesting from a server a communication address for initiating and activating this communication address (col. 3, line 58 through col. 4, line 19); identifying a functionality of a client, which represents an automation component, by using a first configuration data record received from the server (col. 3, line 58 through col. 4, line 19); and configuring the

Art Unit: 2457

client with a second configuration data record received from the server commensurate with the identified functionality (col. 3, line 58 through col. 4, line 19), and starting up the automation component by using the second configuration data record (col. 3, line 58 through col. 4, line 19).

Regarding claims 29, Kumbalimutt discloses a method for automatic configuration of an automation component of an automation system, comprising the steps of: storing on a server a plurality of configuration data records for automation components of the automation system (col. 3, line 58 through col. 4, line 64); a client checking whether it has an initial configuration data record that allows identification of its functionality, and the client requesting, if no initial configuration data record that allows identification of its functionality is present on the client, from the server an initial configuration data record (col. 3, line 58 through col. 4, line 64); the client identifying its functionality based on the initial configuration data record (col. 3, line 58 through col. 4, line 64); the client requesting from the server a second configuration data record commensurate with the identified functionality; and the client automatically loading from the server the second configuration data record and configuring the client (col. 3, line 58 through col. 4, line 64).

Regarding claim 17, Kumbalimutt discloses the method of claim 29, wherein the server stores a plurality of configuration data records in correspondence with a functionality of the client (col. 3, line 47 through col. 4, line 6).

Regarding claim 18, Kumbalimutt discloses the method of claim 29, further comprising the step of autonomous identification of the client within a defined machine context (col. 4, lines 28 - 47).

Regarding claim 19, Kumbalimutt discloses the method of claim 29, wherein at least two of the plurality of configuration data records are stored locally in the client (col. 4, lines 12 - 16).

Regarding claim 20, Kumbalimutt discloses the method of claim 19, further comprising the step of operating the client by activating one of the at least two stored configuration data records in the client (col. 4, lines 51 - 56).

Regarding claim 22, Kumbalimutt discloses the method of claim 29, wherein the client communication is matched to the automation system to enable operation of the client during continuous operation of the automation system (col. 4, lines 48 – 54; Kumbalimutt discloses that the client computer 150 may have been previously configured to use server computer 154 as its Session Initiation Protocol (SIP) server).

Regarding claim 23, Kumbalimutt discloses the method of claim 29, wherein the client and the server operate on a single automation device (figs. 3 - 5).

Regarding claims 24 and 27, Kumbalimutt discloses the method of claims 26 and 29, further comprising the step of loading the configuration data records for different machine upgrade levels for a machine in the server by an engineering system (fig. 4; col. 4, lines 2 – 9; Kumbalimutt discloses inherently that the configuration settings were already loaded on the server).

Art Unit: 2457

Regarding claim 30, Kumbalimutt discloses the method of claim 26, further comprising the steps of loading with an engineering system the first and second configuration data records of a machine only in a server for the machine, and making the first and second configuration data records automatically available to the requesting client (col. 4, lines 19 - 47).

Regarding claim 31, Kumbalimutt discloses the method of claim 29, wherein the client functionality comprises a location or a plug in slot of the client, a type of the automation component, or a specific functionality of the automation component, or a combination thereof (col. 7, lines 29 – 57; col. 11, lines 17 – 29; claims 5 and 12).

Regarding claim 32, Kumbalimutt discloses the method of claim 29 , further including the steps of assigning to the client a temporary dynamic IP address for initial communication with the server; and thereafter activating for the client an IP address corresponding to a functionality of the client (col. 7, lines 29 – 57; col. 11, lines 17 – 29; claims 5 and 12).

Claim 28 incorporates substantively all the limitations of claims 26 and 29, in system form, rather than in method form. The reasons for rejecting claims 26 and 28 apply to claim 28. Therefore, claim 28 is rejected for the same reasons.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kumbalimutt et al (US 7,266,594; hereinafter Kumbalimutt) in view of Righi et al (US 7,363,480; hereinafter Righi).

Regarding claim 21, Kumbalimutt discloses substantially all the limitations in claim 29, but fails to specifically teach the steps of storing pollable firmware data records in the server, transmitting a request from the client to the server for receiving

Art Unit: 2457

one of the firmware data records, and storing and activating the received firmware data record in the client.

However, Righi discloses an analogous method, system, and computer-readable medium for updating the firmware of a computing device via a communications network which comprises the steps of storing pollable firmware data records in the server, transmitting a request from the client to the server for receiving one of the firmware data records, and storing and activating the received firmware data record in the client (figs. 2A & 2B; see abstract; col. 2, lines 24 – 59; col. 3, lines 26 – 33).

Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of Kumbalimutt by incorporating the steps of storing pollable firmware data records in the server, transmitting a request from the client to the server for receiving one of the firmware data records, and storing and activating the received firmware data record in the client as evidenced by Righi for the purpose of assisting with the start up of the client and enabling communication with the low level hardware of the client system, thereby providing an efficient way of configuring a computer /client system.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within

Art Unit: 2457

TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to YVES DALENCOURT whose telephone number is (571)272-3998. The examiner can normally be reached on M-F 8-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ario Etienne can be reached on (571) 272-4001. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2457

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/YVES DALENCOURT/
Primary Examiner, Art Unit 2457